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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,480	08/31/2001	Laurence A. Beck	01CON234P	3226
25700	7590	12/15/2004	EXAMINER	
FARJAMI & FARJAMI LLP 26522 LA ALAMEDA AVENUE, SUITE 360 MISSION VIEJO, CA 92691			ENG, GEORGE	
			ART UNIT	PAPER NUMBER
			2643	
DATE MAILED: 12/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/945,480

Applicant(s)

BECK, LAURENCE A.

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 12 on page 25, line 12 should be renumbered as claim 13 to be corrected.

2. Claim 13 is objected to because of the following informalities: page 25, line 12, "claim 7" should be --claim 8-- to be corrected because claim 7 is a method claim, which is different from claim 8 and claim 13, i.e., apparatus claim. Appropriate correction is required.

Drawings

3. The drawings were received on 1/17/2002. These drawings are acceptable.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,731,726. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations, i.e., the steps of receiving an alert signal from said central office indicating an incoming call, acknowledging said alert signal, notifying said remote modem of a modem-on-hold state, collecting calling identification, informing said host of said alert signal, receiving an in-band caller identification request, and transmitting call identification to said host, and receiving an in-band answer request from said host to answer said incoming call, are transparently found in claims 1-27 of U.S. Patent No. 6,731,726 with obvious wording variations.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 14-20 are rejected to be unpatentable under 35 U.S.C. 101 as being nonstatutory.

Independent claim 14 taken as whole is directed merely to a computer software product recited as being “for providing communication between a local modem and a host while said local modem is in communication with a remote modem through a central office”. The body of claim only describes or expresses of potential functionality within the “code for...” elements of the computer software program. Thus, taken as a whole, independent claim 14 amounts to merely a computer software program, without any computer readable medium to realize the potential functionality or intended use of the program.

Claims 15-20 are also rejected because of depending on claim 97 containing the same deficiency.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Civanlar et al. (EP 0741481A2 hereinafter Civanlar) in view of DePond et al. (US PAT. 6,317,488 hereinafter DePond).

Regarding claim 1, Civanlar discloses a communication for use between a local modem (102, figure 1) and a host (106, figure 1) while said local modem is in communication with a remote modem 104, figure 1) through a central office, said method comprising the steps of

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receiving an alert signal from said central office indicating an incoming call, acknowledging said alert signal, notifying said remote modem of a modem-on-hold state, informing said host of said alert signal, and receiving an in-band answer request from said host to answer said incoming call (col. 3 line 33 through col. 8 line 12). Civanlar differs from the claimed invention in not specifically teaching the steps of collecting caller identification received from said central office, receiving an in-band caller identification request from said host for said caller identification, and transmitting said caller identification to said host using an in-band caller identification message. However, DePond teaches a telephone call manager for collecting caller identification received from the central office by transmitting a caller identification request to the central office for the caller identification and receiving the caller identification from the central office using an in-band signaling message (col. 2 line 39 through col. 3 line 22), thereby providing notification of incoming call waiting and call waiting caller ID while the telephone line is being used by a computer modem. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Civanlar in having the steps of collecting caller identification received from said central office, receiving an in-band caller identification request from said host for said caller identification, and transmitting said caller identification to said host using an in-band caller identification message, as per teaching of DePond, in order to provide notification of incoming call waiting and call waiting caller ID while the telephone line is being used by the computer modem.

Regarding claim 2, Civanlar discloses the step of receiving a hold acknowledgement from the remote modem in response to the notifying step (col. 7 lines 24-27).

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Regarding claim 3, Civanlar teaches the hold acknowledgment including a hold time, wherein the method further comprising the steps of receiving an in-band hold time request from the host and transmitting said hold time to the host using an in-band hold time message (col. 9 lines 21-42).

Regarding claim 4, Civanlar teaches the step of requesting the remote modem to enter the modem-on-hold state (col. 7 lines 33-36).

Regarding claims 5-6, DePond teaches the step of informing uses a ring signal or in-band ring message to inform the host of the alert signal (col. 2 lines 61-65).

Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 3.

Regarding claim 11, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claims 12-13, the limitations of the claims are rejected as the same reasons set forth in claims 5-6.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 15, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claim 16, the limitations of the claim are rejected as the same reasons set forth in claim 3.

Regarding claim 17, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claims 18-19, the limitations of the claims are rejected as the same reasons set forth in claims 5-6.

10. Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Civanlar et al. (EP 0741481A2 hereinafter Civanlar) in view of DePond et al. (US PAT. 6,317,488 hereinafter DePond) as applied to claims above, and further in view of O'Horo et al. (US PAT. 5,519,767 hereinafter O'Horo).

Regarding claim 7, the combination of Civanlar and DePond differs from the claimed invention in not specifically teaching the steps of receiving a disconnect reply from said remote modem in response to the notifying step and transmitting a disconnect request to said remote modem after the host informs the local modem of its desire to answer the incoming call. However, O'Horo teaches such (figure 3 and col. 4 line 49 through col. 5 line 22). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Civanlar and DePond in having the steps of receiving a disconnect reply from said remote modem in response to the notifying step and transmitting a disconnect request to said remote modem after the host informs the local modem of its desire to answer the incoming call, as per teaching of O'Horo, in order to simplify the construction of modem.

Regarding claim 20, the limitations of the claim are rejected as the same reasons set forth in claim 7.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cai et al. (US PAT. 5,550,908) discloses modem communications interoperability with service equipped to provide calling party identity delivery with call waiting (abstract).

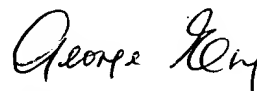
Liang et al. (US 2004/0174967A1) discloses a method and software for call waiting tone detection (abstract).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George Eng
Primary Examiner
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